

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

GOLDBERG et. al.

Application No. 09/502,285

Filed: Feb. 11, 2000

Atty. Docket No.: 3367-2-2

For: "A NETWORKED SYSTEM FOR
PRESENTING ADVERTISING"

) Group Art Unit: 3714

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) Examiner: Robert E. Mosser

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) Confirmation No. 4950

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**COMMENTS ON
REASONS FOR ALLOWANCE**

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant's representative submits this Comments on Reasons for Allowance in response to the reasons for allowance attached in the Notice of Allowance having a mailing date of January 13, 2009.

In the Notice of Allowance, the Examiner stated reasons for allowance for the allowed Claims 360-446, 448-449, 451-454, 456, 458-464, and 466-474 is that:

"The prior art of record when considered alone or in combination does not teach or reasonably provide for the delivery unsolicited advertisement to a user through an overlay presentation in the detail as described by the pending claims."

As is clear from MPEP 1302.14:

"The statement [of reasons for allowance] is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not

be written to specifically or impliedly state that all the reasons for allowance are set forth.”

For clarification of the record, Applicant’s representative understands the reasons for allowance of the Examiner’s “the presented reasons for allowance” to be a general reference to features related to the allowed claims. However, Applicant’s representative respectfully submits that “the delivery unsolicited advertisement to a user through an overlay presentation” of the Examiner’s reasons for allowance is not recited in any of the allowed claims. Accordingly, it is respectfully submitted that the allowed claims have a scope commiserate with the claim language of each allowed claim. In particular, it is believed that the steps of each allowed claim provide for the patentability thereof regardless of whether there is provision for the delivery of unsolicited advertising to a user through an overlay presentation.

Moreover, Applicant’s representative respectively point out to the Examiner the following features of the allowed independent claims :

(A) Regarding independent Claim 360, this claim includes a step of:

“overlapping *with* a display” of presentations of information for an interactive service, a (first) one or more advertising presentations.

Such “overlapping with” as described in at least one embodiment in the specification may be interpreted as “overlapping, *in time, with* a display”.

(B) Regarding independent Claim 361, this claim recites the limitation:

“obtaining information related to an efficacy of one or more of the advertising presentations presented to the user, including determining information related to a number of advertised items that are sold through the one or more advertising presentations”

which is believed to contribute to the patentability of the present claim.

(C) Regarding independent Claim 368, this claim recites the following combination of limitations of steps E, I, J, and K which are believed to contribute to patentability thereof.

(D) Regarding independent Claim 399, this claim includes:

(in Step F) providing a plurality of advertisers with “corresponding advertising effectiveness information” for a plurality of network users.

(E) Regarding independent Claim 401, this claim includes as the following limitation:

“wherein an advertising presentation, AP₁, of said sequence [of advertising presentations] is presented as a consequence of one or more particular communications on the first Internet connection between said service node and the user node, said particular communications being transmitted separately of all [of the plurality of] service transmissions from the instance [of the service] to the user node”.

- (F) Regarding independent Claim 403, this claim includes steps for communicating with a “service providing node” of the Internet, wherein as a result of communication between the “service providing node” and each user, “first information” is stored on the user’s node, wherein “an Internet transmission indicative of the first information being present on the user node” is received for a service “after the user node has established the subsequent Internet connection session”. Moreover, limitations regarding the transmission and display of advertising and service presentations for the “subsequent Internet connection session” are recited in the present claim, as well as, limitations related to an action by the user, in response to an advertisement, wherein:

“a response to the action by the user is received at the user node, via the Internet, the response providing another presentation for presenting to the user at said user node”.

- (G) Regarding independent Claim 416, this claim includes the following limitations:

- (a) “wherein the transmitting step results in first information being stored on the user node so that it is available in a subsequently established Internet connection session by the user at the user node;”
- (b) “wherein for one or more of the at least some Internet transmissions, in addition to including their corresponding service related information, each of the one or more of the at least some Internet transmissions includes corresponding advertising related information combined with service related information prior to transmission to the user node, said corresponding advertising related information replaceable with alternative information without changing a content of the corresponding service related information to which the user responds with the corresponding responsive Internet transmission;” and

- (c) “wherein when presenting a content for each of the one or more of the at least some Internet transmissions to the user, a corresponding advertisement obtained using the corresponding advertising related information is presented to the user, wherein the corresponding advertisement provides information to the user: (i) related to one or more purchasable products or purchasable services, and (ii) that allows the user to perform an Internet transmission, T, for obtaining additional information about one or more purchasable products or purchasable services.”
- (H) Regarding independent Claim 430, this claim includes the following features:
 - “(F) obtaining advertising data for presenting advertising of one or more of a purchasable product or a purchasable service for one of a plurality of advertisers;
 - (G) combining the advertising data and the second game data resulting in combined data;
 - (H) second transmitting, on the network and from the game playing source, the combined data, the combined data for presenting at the user node a combined presentation of the subsequent game presentation and an advertising presentation corresponding to the advertising related data, wherein the advertising presentation has predetermined network link data associated therewith such that the link data is activated by a user input to the advertising presentation resulting in a corresponding network transmission of data indicative of said user input being transmitted to a predetermined network site which provides the user node with access to the advertising presentation, the network site being different from the gaming playing source; and
 - (I) receiving access information indicative of the advertising presentation being accessed by the user, wherein the access information is used in deriving advertising effectiveness information which is subsequently made available to the one advertiser.”

The Examiner's reasons for allowance do not reference limitations set forth in the subclaims which are believed to include further patentable subject matter and thus overcome all known prior art.

Applicant's representative respectfully submits that the allowed claims satisfy all U.S.C. 101, 112, 102 and 103 criteria for patentability. Moreover, since the Examiner has reviewed all known prior art for U.S.C. 112, 102 and 103 rejections, it is believed that the Examiner's reasons for allowance are meant to imply that the Examiner fully considered all combinations of the known prior art. More specifically, unless the Examiner disagrees, it is believed that the Examiner has fully considered all combinations of the known prior art, and that the prior art fails to teach the combinations of features of each of the independent claims, as well as, such features in combination with the limitations of their respective subclaims.

Should the Examiner disagree with the comments above, it is respectfully requested that the Examiner contact the undersigned as soon as possible so that a common understanding of the reasons for allowance can be agreed upon.

Applicant's representative believes that no additional fees are due with the filing of this Response to the Reasons for Allowance. However, in the event that additional fees are due, the undersigned hereby authorizes the charge of any such fees deemed necessary to Deposit Account No. 19-1970.

Respectfully submitted,
SHERIDAN ROSS P.C.

Date: Feb. 13, 2009

By: /Dennis J. Dupray/

Dennis J. Dupray

Reg. No. 46,299

1560 Broadway, Suite 1200

Denver, Colorado 80202

Telephone: 303-863-2975

Fax: 303-863-0223